



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,294	04/11/2000	Glen Sharp	SYMA-01043USOMCF/SES	4987

23910 7590 07/14/2003

FLIESLER DUBB MEYER & LOVEJOY, LLP
FOUR EMBARCADERO CENTER
SUITE 400
SAN FRANCISCO, CA 94111

EXAMINER

WANG, LIANG CHE A

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 07/14/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/547,294

Applicant(s)

SHARP ET AL.

Examiner

Liang-che Alex Wang

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-26 have been examined.

Priority

2. The drawings in this application are objected to by the Draftsperson as informal. Any drawing corrections requested, but not made in the prior application should be repeated in this application if such changes are still desired. If the drawings were changed and approved during the prosecution of the prior application, a petition may be filed under 37 CFR 1.182 requesting the transfer of such drawings, provided the parent application has been abandoned. However, a copy of the drawings as originally filed must be included in the 37 CFR 1.60 application papers to indicate the original content.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over DynamicAccess® Technology, 3COM Technical Paper, hereinafter DynamicAccess in views of Davis et al., US Patent Number 5,937,160 hereinafter Davis.

Art Unit: 2155

5. Referring to claim 1, DynamicAccess has taught a method for updating a configuration specification of a computer, the method comprising the steps of:

- a. receiving a configuration file from administrator (page 10, col. 1, lines 29-30) containing location settings (page 10, col. 1, lines 17-22);
- b. writing location values corresponding to the location settings into the configuration specification of the computer (page 10, col. 1, lines 1-33.)

DynamicAccess however has not explicitly taught the configuration is sent to the user through e-mail.

However, Davis has explicitly taught that any non-text file could be included with an e-mail message as attachment. (Col 12, lines 43-45.)

A person with ordinary skill in the art would have recognized that the main purpose of the invention is to allow the administrator to send configuration file to the client's computer. And using e-mail attachment has been a well-known method to send file from one computer to another.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to have an e-mail containing location settings encoded in an attachment, and let the user to receive the e-mail and to have the user's computer configured by opening the attachment as taught by Davis, because e-mail attachment has been a well-known method to communicating files between computers.

6. Referring to claim 2, DynamicAccess in views of Davis have taught an invention as described in claim 1, DynamicAccess in views of Davis had further included the configuration includes a destination of a location name corresponding to the

configuration specification (page 10, configuration sending from the administrator to the remote site must contain the destination for the location name corresponding to the configuration specification, otherwise the invention would not work for its purpose;) and wherein configuration specification of the computer corresponds to the location name. (page 1, the configuration is set by the administrator for a particular computer at a particular location so the client could work properly at the location and it is the whole purpose of DynamicAccess's invention, therefore the configuration specification of the computer must corresponds to the location name.)

7. Referring to claim 3, DynamicAccess in views of Davis have taught an invention as described in claim 1, DynamicAccess has further taught wherein the location settings are generically defined so as to apply to a variety of operating systems. (Page 10, col. 2, lines 41-47; DynamicAccess could be used on a variety of operating system.)
8. Referring to claim 4, DynamicAccess in views of Davis have taught an invention as described in claim 3, DynamicAccess has further taught determining an operating system type for the computer; and generating the location values by interpreting the location settings for the operating system type for the computer. (Page 10, paragraph 18 already stated that the invention could be applied to a variety of operating systems, therefore when the configuration file is sent from the administrator to the client, the operating system must be determined, and the location values must be generated by interpreting the location settings for the operating system type for the computer, so the location settings for this particular operating system could be configured into this particular computer.)

9. Referring to claim 5, DynamicAccess in views of Davis have taught an invention as described in claim 4, DynamicAccess has further taught wherein the interpreting step is performed by referring to program logic which translates the location settings into location values as a function of the operating system type for the computer. (Page 10, paragraphs 19 already stated that the invention could be applied to a variety of operating systems, and there must have program logic to translate the location settings into location values for the computer.)
10. Referring to claim 6, DynamicAccess in views of Davis have taught an invention as described in claim 5, DynamicAccess has further taught wherein the location settings specify Internet settings. (Page 10 Col 1, lines 17-22.)
11. Referring to claim 7, DynamicAccess in views of Davis have taught an invention as described in claim 5, DynamicAccess has further taught wherein the location settings specify an internet protocol address, a domain name server configuration, a gateway and a WINS configuration. (Page 10 Col 1, lines 17-22.)
12. Referring to claim 8, DynamicAccess in views of Davis have taught an invention as described in claim 5, DynamicAccess has further taught wherein the location settings specify dialing settings or local area network settings. (Page 10 Col 1, lines 17-22.)
13. Referring to claim 9, DynamicAccess has taught a method for providing user's client computer with configuration settings, the method comprising the steps of:
 - a. specifying a location name for the user's client computer (page 10, col 1, lines 17-33, the location name must be specified, since the location setting is provided for this specific location;)

Art Unit: 2155

- b. specifying location settings corresponding to the location name (page 10, col 1, lines 17-33;)
- c. sending the configuration to the use (page 10, col 1, lines 4-8.)

DynamicAccess however has not explicitly taught the configuration is sent to the user through e-mail.

However, Davis has explicitly taught that any non-text file could be included with an e-mail message as attachment. (Col 12, lines 43-45.)

A person with ordinary skill in the art would have recognized that the main purpose of the invention is to allow the administrator to send configuration file to the client's computer. And e-mail attachment has been a well-known method to send file from one computer to another.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to create an e-mail containing location settings encoded in an attachment, and send the e-mail and to the user as taught by Davis, because e-mail attachment has been a well-known method to communicating files between computers.

- 14. Referring to claim 10, DynamicAccess in views of Davis have taught an invention as described in claim 9, DynamicAccess has further taught wherein the location settings are generically defined so as to apply to a variety of operating systems. (Page 10, col. 2, lines 41-47; DynamicAccess could be used on a variety of operating system.)
- 15. Referring to claim 11, DynamicAccess in views of Davis have taught an invention as described in claim 10, DynamicAccess has further taught wherein the location settings specify Internet settings. (Page 10 Col 1, lines 17-22.)

16. Referring to claim 12, DynamicAccess in views of Davis have taught an invention as described in claim 10, DynamicAccess has further taught wherein the location settings specify an internet protocol address, a domain name server configuration, a gateway and a WINS configuration. (Page 10 Col 1, lines 17-22.)
17. Referring to claim 13, DynamicAccess in views of Davis have taught an invention as described in claim 10, DynamicAccess has further taught wherein the location settings specify dialing settings or local area network settings. (Page 10 Col 1, lines 17-22.)
18. Referring to Claims 14-21, Claims 14-21 encompass the same scope of the invention as that of the Claims 1-8. Therefore, the Claims 14-21 are rejected for the same reason as the Claims 1-8.
19. Referring to Claims 22-26, Claims 22-26 encompass the same scope of the invention as that of the Claims 9-13. Therefore, the Claims 22-26 are rejected for the same reason as the Claims 9-13.

Response to Arguments

20. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, paper number 6, mailed 01/02/03.
21. Applicant's arguments filed 06/24/03, paper number 8, have been fully considered but they are not persuasive.
22. In that remarks, applicant's argues in substance:
 - a. That: "Claims 1-26 are believe to be allowable since ther are believed to be no suggestion to combined the Davis et al, and Dynamic Access Technology

Art Unit: 2155

references. The Davis et al., and Dynamic Access Technology refer to two different types of software.... Since these references deal with two different types of software applications, it would not be obvious to combine these references to produce the present claimed invention" on page 12 lines 3-11.

This is found not persuasive because In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dynamic Access Technology has taught most of the limitation of applicant's invention except the limitation of configuration file is sent to an user through an e-mail as an attachment. And Davis provides the teaching of any non-text file can be attached in a e-mail and send to a user. Davis does not ^{necessarily} ~~necessary to~~ teach all the configuration part of the invention since Dynamic Access Technology has already taught it. A person with ordinary skill in the art would have been motivated to send non-text files with includes the configuration file through e-mail, since it is known in the art to transfer non-text files through e-mail attachments.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (703) 305-8159. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.
26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on (703)308-6662. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.
27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

Application/Control Number: 09/547,294

Page 10

Art Unit: 2155

Liang-che Alex Wang *lw*
July 9, 2003

HL
HOSAIN T. ALAM
PRIMARY EXAMINER